

**Section III (Amendments to the Drawings)**

Please amend the drawings by substituting the enclosed replacement drawing sheets 1-3 (inclusive of Figures 1-3) for drawing sheets 1-3 as originally filed.

**Section IV (Remarks)****A. Application Status**

A Final Office Action was mailed in the present application on November 15, 2006. Applicant submitted a first Response to such Final Office Action on December 4, 2006. Thereafter, on December 22, 2006, Applicant submitted a Supplemental Response to such Final Office Action and a Declaration of Jeff Grady including evidence of secondary considerations of non-obviousness of the claimed subject matter. On January 11, 2007, an Advisory Action was issued, with such Advisory Action indicating that Applicant's proposed amendments would not be entered, and that claims 10, 23, and 52-68 remain rejected, while claims 1, 3-6, 8, 9, 11, 14-22, 24, 27, and 29-51 have been allowed.

**B. Applicant's Summary of Examiner Interview on December 20, 2006**

On December 20, 2006, the undersigned called the Examiner to request deferral of any action on Applicant's Response filed on December 4, 2006 because Applicant was then preparing and planning to file Supplemental Response including evidence of secondary considerations of non-obviousness. The Examiner agreed to defer action on Applicant's Response filed on December 4, 2006 pending receipt of a Supplemental Response. No discussions were made of the substance of the claims.

The foregoing interview summary by Applicant is provided in response to the Examiner's Interview Summary as transmitted on January 11, 2007, pursuant to MPEP 713.04. Since the period for responding to such Interview Summary was set at thirty days from the mailing of the Interview Summary (or Saturday, February 10, 2007), the present interview summary is timely filed pursuant to 35 U.S.C. 21(b) ("[w]hen the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.")

**C. Remarks Regarding Non-Entry of Response Dated December 4, 2006 Premised on Alleged "New Matter"**

The January 11, 2007 Advisory Action stated:

Applicant's amendment filed on December 4, 2006 will not be entered because it raises the issue of a new matter. The amendment to the specification on page 8 such **control elements 17A, 17B** and frequency indicator 19 may be placed on **any portion of the body 11** including the modular docking unit 16 (emphasis added by examiner) is not supported by the original specification. More specifically, the original specification only discloses "a frequency tuning control" (see original claim 13), not two control elements 17A and 17B. The original specification only discloses the control element and frequency indicator placed on the modular docking unit 16, not on any portion of the body 11.

Advisory Action, page 2.

Applicant takes issue with the Examiner's refusal to enter Applicant's Response dated December 4, 2006, since such Response contained no new matter.

Not all matter added to the disclosure after the filing date of a patent application is "new" within the meaning of 35 U.S.C. 132 — material that is implicit, intrinsic, or inherent in the application as filed is not new matter. Thus, disclosure contained in any one of the written description, claims, or drawings of the application as filed may be subsequently added by amendment to any other part of the application without introducing new matter. See, e.g., MPEP § 608.01(I).

It is not improper to add element numbers to elements previously presented in drawings; in fact, such practice is required if such element numbers are missing and the element is described or claimed. See MPEP 608.02(e); 37 CFR 1.84(p)(5) ("Reference characters mentioned in the description must appear in the drawings."); 37 CFR §§ 1.84(c), 1.84(w) & 1.85 (providing for corrections of drawings following the filing of an application).

In alleging that the Response filed December 4, 2006, the Examiner relied solely upon the TEXT of the specification and improperly ignored the drawings as a basis for disclosure in evaluating whether new matter was presented.

"[I]t is well settled that drawings may be relied upon to satisfy the disclosure requirements of 35 USC §112. See *In re Berkman*, 642 F.2d 427, 209 USPQ 45 (CCPA 1981), citing *Breen v. Cobb*, 487 F.2d 558, 179 USPQ 733 (CCPA 1973); *In re Reynolds*, 58 CCPA 1287, 443 F.2d 384, 170 USPQ

94 (1971); *In re Wolfensperger*, 49 CCPA 1075, 302 F.2d 950, 133 USPQ 537 (1962).

*Ex parte Horton*, 226 USPQ 697, 699 (B.P.A.I. 1985).

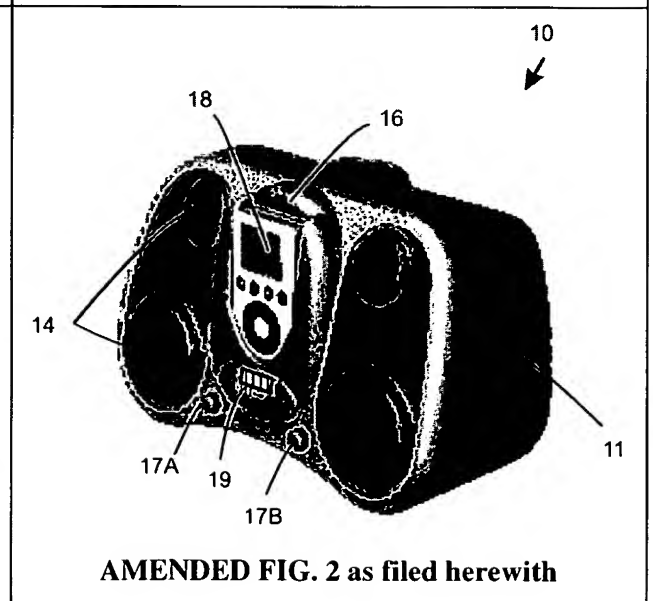
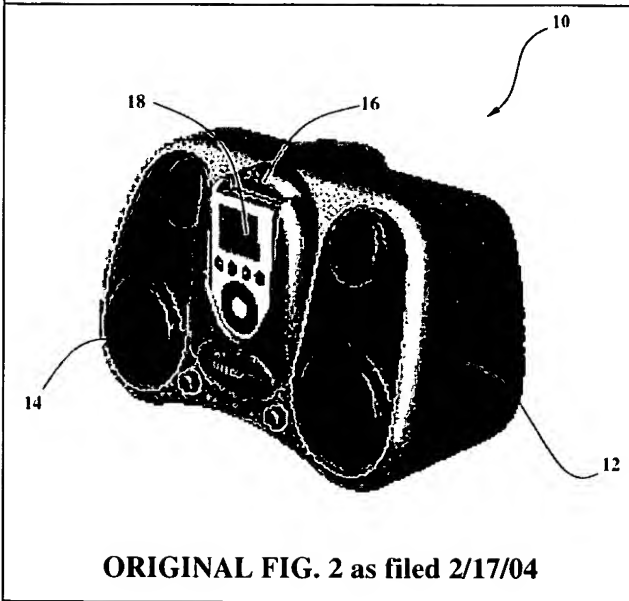
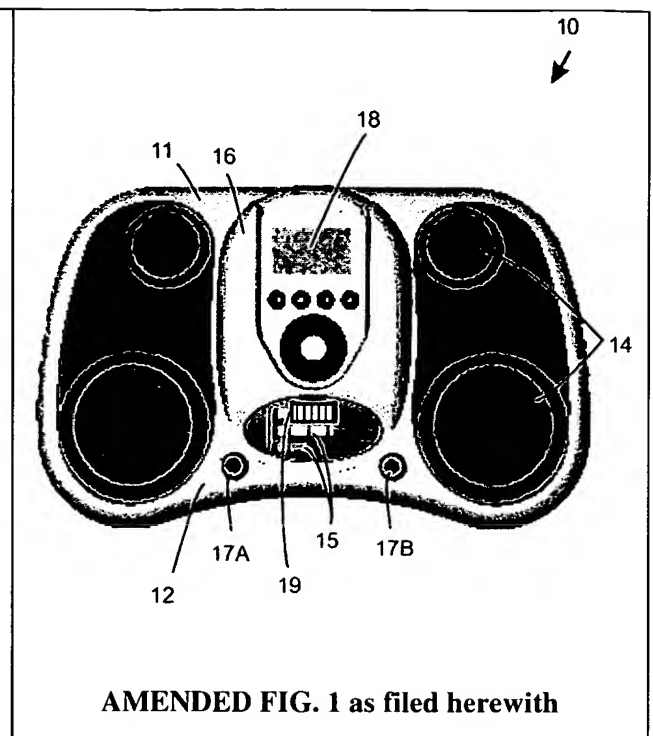
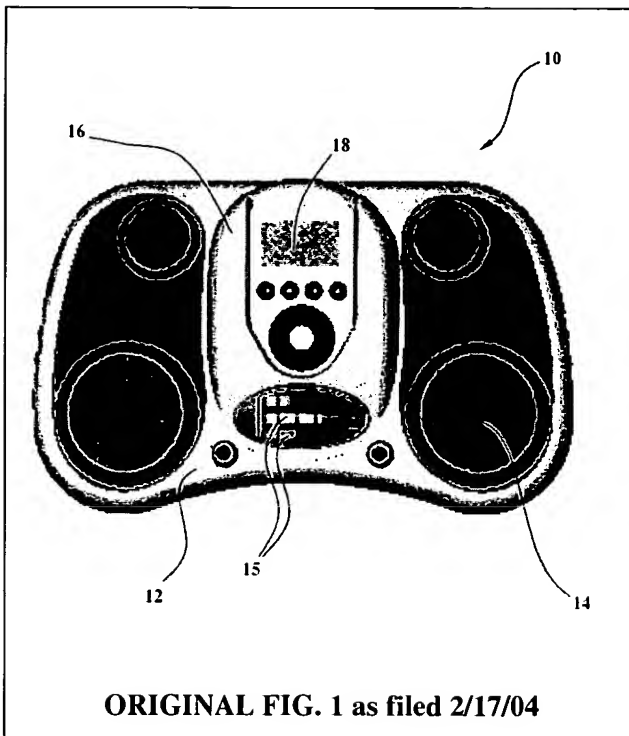
Similarly, the Federal Circuit has stated:

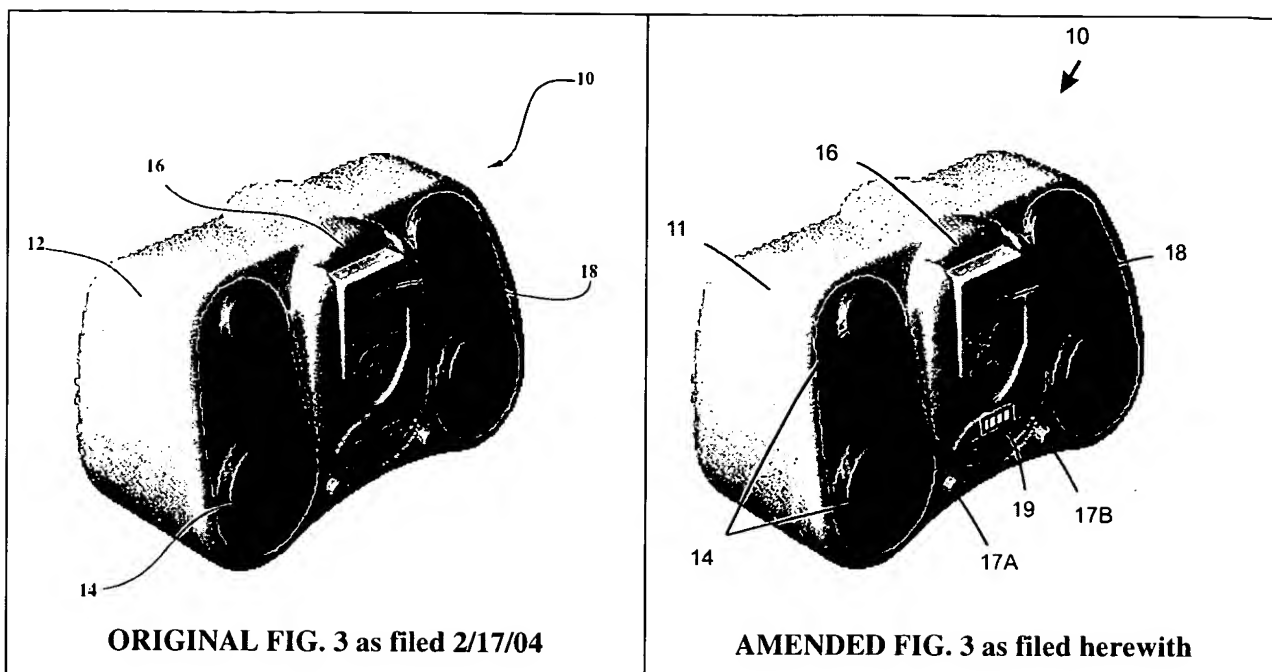
**“drawings alone may provide a written description of an invention** as required by § 112. ... Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed.”

*Cooper Cameron Corp. v. Kvaerner Oilfield Prods.*, 291 F.3d 1317, 62 USPQ2d 1846, 1850 (Fed. Cir. 2002).

When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not “new matter” is involved. MPEP 2163.06 (“Relationship of Written Description Requirement to New Matter”).

In Applicant’s first after-final Response filed on December 4, 2006, new drawing sheets 1-3 were submitted. The original drawing sheets and the amended drawing sheets are reproduced below to permit direct side-by-side comparison. Such comparison of the amended drawing sheets against the original drawing sheets shows that **two cylindrical knobs** – originally unlabeled with any element numbers, but now labeled as elements 17A, 17B) **were clearly disclosed in the original drawings**. The clear implication of such knobs is that they are useable as control elements. Moreover, the placement of such knobs or control elements 17A, 17B well below the structure labeled as element 16 and described as a modular docking unit 16, **shows that indeed such control elements 17A, 17B may be disposed on the body apart from the modular docking unit 16**.





Clearly, the raised cylindrical knobs (control elements) now labeled as elements 17A and 17B were prominently displayed in the original drawings. Mere addition of element numbers to these pre-existing knobs or control elements does NOT constitute new matter. Moreover, it is noted that these elements 17A, 17B appear well below the modular docking unit 16, such that the application clearly discloses their placement on the body in locations other than the modular docking unit.

While Applicant maintains that the amendments to the specification submitted December 4, 2006 failed to present any new matter, the present Response contains slightly different language amending the second paragraphs of page 7 and page 8 to eliminate any dispute over the new matter issue. Entry of the accompanying amendments to the specification is respectfully requested.

#### **D. Response to Drawing Objections Premised on Alleged “New Matter”**

In the January 11, 2007 Advisory Action, the drawings were not approved as allegedly containing new matter. Advisory Action, page 2. In support of such objection, the Examiner stated:

More specifically, the original specification discloses that the docking unit 16 comprises a frequency tuning control (see original claim 13). However,

amended figures 1-3 show two to frequency tuning control [sic - *controls*] 17A and 17B, and these two frequency control [sic – *controls*] are located outside of the docking unit 16.

Advisory Action, page 2.

The arguments raised in Section III.C of the present Response are equally apposite here. As provided in the preceding side-by-side presentation of the original and amended drawings, the **raised cylindrical knobs (control elements) now labeled as elements 17A and 17B were prominently displayed in the original drawings.** Mere addition of element numbers to these pre-existing knobs or control elements does NOT constitute new matter. Moreover, it is noted that these elements 17A, 17B appear well below the modular docking unit 16, such that the application clearly discloses their placement on the body in locations other than the modular docking unit.

Furthermore, Applicant has never stated or suggested that BOTH control elements 17A, 17B were to be used for frequency tuning. To the contrary, Applicant's prior attempt to amend the specification on December 4, 2006 stated that such "control elements 17A, 17B ... may be applied to various functions including frequency tuning control." In Applicant's first commercial product called the IBOOM – which product closely resembles the device of FIGS. 1-3 - one knob or control element is used for frequency tuning control, and the other knob or control element is used for volume control.

Since the original drawings clearly show two knobs or control elements disposed outside of the modular docking unit, the addition of element numbers to these same elements in the amended drawings does NOT constitute new matter.

The amended drawings submitted herewith are identical to those filed by Applicant on December 4, 2006. Since these drawings contain no new matter, no "new matter" objection under 35 U.S.C. 132 to the amended drawings is warranted.

#### **E. Summary of Amendments Made Herewith**

By the present amendment, claims 10, 15, 17, 23, 30, 52, and 56 have been amended; claims 8 and 29 have been cancelled; the second paragraphs of each of pages 7 and 8 of the specification

have been amended; and replacement drawing sheets 1-3 have been substituted for the corresponding drawing sheets 1-3 as originally filed. The additions to claim 52 in particular are supported in the specification at page 6, fourth paragraph. No new matter within the meaning of 35 U.S.C. 132 has been introduced by the foregoing amendments.

**F. Response to Claim Rejections Under 35 U.S.C. 112**

In the November 15, 2006 Office Action, claims 10, 23, and 56 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement since the original specification purportedly fails to disclose an IEEE 1394-compliant coupling.

Applicant disagrees with the 112 rejection in that Firewire® (as originally recited) is one example of an IEEE 1394-compliant coupling, but for the sake of avoiding further conflict and promoting rapid allowance of the application, claims 10, 23, and 56 have been amended to remove any recitation of an IEEE 1394-compliant coupling.

In view of these amendments, the claim rejections under 35 U.S.C. 112 should be withdrawn, and withdrawal of such rejections is respectfully requested.

**G. Response to Claim Rejections Under 35 U.S.C. 103(a)**

In the November 15, 2006 Office Action, claims 52-68 were rejected for obviousness on various prior art grounds, namely:

- Claims 52-60 and 62-68 were rejected under 35 U.S.C. 103(a) as being unpatentable for obviousness over U.S. Patent Application Publication No. 2004/0224638 to Fadell (“Fadell”) in view of U.S. Patent Application Publication No. 2002/0002039 to Qureshey (“Qureshey”); and
- Claim 61 was rejected under 35 U.S.C. 103(a) as being unpatentable for obviousness over Fadell and Qureshey as applied to claim 52, and further in view of U.S. Patent Application Publication No. 2002/0086703 to Dimenstein (“Dimenstein”).

Such rejections are traversed, as detailed below.



## 1. Law Regarding Obviousness Rejections

Concerning § 103 obviousness rejections, three requirements must be met for a *prima facie* case of obviousness. First the prior art reference(s) must teach all of the limitations of the claims. M.P.E.P. § 2143.03. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. M.P.E.P. § 2143.01. Third, a reasonable expectation of success is required. M.P.E.P. § 2143.02.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. *Arkie Lures, Inc., v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). The fact that references could conceivably be modified or combined is insufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

A *prima facie* case of obviousness can be rebutted, *inter alia*, by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997), *citing In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

## 2. Discussion of Fadell and Comparison to Claim 52

### (a) Fadell Clearly Teaches Wireless Transmission of Media Signals From a Portable MP3 Player to an External Media Device - NOT Reception by a Docking-Cavity-Containing Audio Player of "Radio Signals from Radio Stations"

Fadell discloses various embodiments of a media player system that allow a portable digital media player (e.g., such as an Apple Computer iPod®) to communicate with other media devices.

Fadell emphasizes over and over again that the purpose and thrust of the invention described therein is to **permit communication, whether wired or wireless, between a portable media player and other media devices**. See, e.g., the following passages from Fadell:

[0007] The invention relates, in one embodiment, **to a docking station that allows a media player to communicate with other media devices**.

[0008] The invention relates, in another embodiment, to a wireless media player system. The wireless media player system includes a hand held media player (e.g., music player) capable of transmitting information over a wireless connection. The wireless media player system also includes one or more media devices (e.g., tuning devices) capable of receiving information over the wireless connection.

[0009] The invention relates, in another embodiment, to a method of wirelessly connecting a hand held media player to another device. The method includes selecting a media item on the hand held media player. The method also includes selecting one or more remote recipients on the hand held media player. The method further includes transmitting the media item locally to the hand held media player, and wirelessly to the selected remote recipients.

[0010] The invention relates, in another embodiment, to a **hand held music player (e.g., MP3 player) that includes a transmitter** for transmitting information over a wireless connection. The **transmitter is configured to at least transmit a continuous music feed to one or more personal tuning devices that each include a receiver** capable of receiving information from the transmitter over the wireless connection.

[0041] The term "**media player**" generally refers to **computing devices that are dedicated to processing media such as audio, video or other images**, as for example, music players, game players, video players, video recorders, cameras, and the like. In some cases, the media players contain single functionality (e.g., a media player dedicated to playing music) and in other cases the media players contain multiple functionality (e.g., a media player that plays music, displays video, stores pictures and the like). In either case, **these devices are generally portable** so as to allow a user to listen to music, play games or video, record video or take pictures wherever the user travels.

[0055] In the illustrated embodiment, the media player includes a headphone jack 116 and a data port 118. ... The **data port 118 ... is capable of receiving a data plug/cable assembly configured for transmitting and receiving data to and from a host device** such as a general purpose computer (e.g., desktop computer, portable computer). By way of example, the **data port 118 may be used to upload or down load audio, video and other images to and from the media device 100**. For example, the data port may be used to download songs and play lists, audio books, ebooks, photos, and the like into the storage mechanism of the media player.

[0056] The data port 118 may be widely varied. For example, the data port may be a PS/2 port, a serial port, a parallel port, network interface port, a USB port, a Firewire port and/or the like. In some cases, **the data port 118 may be a wireless link** such as a radio frequency (RF) link or an optical infrared (IR) link in order to eliminate the need for a cable. ... .

[0058] FIG. 2 is a diagram of a media player system 150, in accordance with one embodiment of the present invention. The **media player system comprises a media player 152 and one or more media devices 154 that are connected via a media link 156.** ... **Media devices 154 are similar to the media player 152 in that they process media such as audio, video or other images.** The media devices may be widely varied. By way of example, the media devices may correspond to other media players, desktop computers, notebook computers, personal digital assistants, video or imaging equipment (e.g., cameras, monitors), audio equipment (home stereos, car stereos, boom boxes), family radios (e.g., walkie talkies), peripheral devices (e.g., keyboards, mice, displays, printers, scanners), personal media devices (discussed in greater detail below) and the like.

[0059] The **media devices 154 and the media player 152 are configured to communicate with one another through media link 156**

[0060] The **media link 156 may be wired and/or wireless.** For example, the media link 156 may be made through connectors and ports or through receivers, transmitters and/or transceivers. The media link may also be one way or two way. For example, in the case of one way, the media player may be configured to transmit signals to the media device but not to receive information from the media device (or vice versa) or in the case of two way, both the media player and media device may be enabled to receive and transmit signals therebetween. The signals may be data (analog, digital), power (AC, DC), and/or the like. In most cases, the data corresponds to data associated with the media player as for example audio, video, images and the like.

[0063] In wireless connections, the media terminals 158 do not physically connect. For example, **the media player 152 and the media device 154 may include a receiver and transmitter for wireless communications therebetween.** By way of example, the connection interface may include one or more of the following interfaces: FM, RF, Bluetooth, 802.11 UWB (ultra wide band), IR, magnetic link (induction) and/or the like.

[0096] FIG. 15 is a diagram of a wireless communication system 400, in accordance with one embodiment of the present invention. The **wireless communication system 400 generally includes a media player 402 and one or more media devices 404.** The media player 402 is configured to send media via a wireless communication link 406 to the media devices 404 and the media devices 404 are configured to receive the media sent by the media player 402 over the wireless communication link 406. The media player is essentially

configured to act as a personal transmitting station so that the user can transmit media stored on the media player to other devices. In some cases, the media devices 404 may also send media to the media player 402 and the media player 402 may also receive media from the media devices 404. By way of example, the media may generally correspond to audio, video, images, text and the like.

[0097] **In order to send and receive media, the players and devices 402 and 404 generally include a transmitter, a receiver or a transceiver as well as some sort of antenna.** The media is generally sent via the transmitter and the media is generally received via the receiver. In one embodiment, the media player includes a transmitter while the media devices include a receiver (for one way communications). In another embodiment, both devices include a transceiver (for two way communications). The antenna may be fully contained within the players/devices 402 and 404 or they may extend outside the devices (as shown). By way of example, the wireless communication link may correspond to FM, RF, Bluetooth, 802.11, UWB (ultra wide band), IR (infrared), magnetic link (induction) and/or the like.

[0103] FIG. 16 is a block diagram of a wireless communication system 420, in accordance with one embodiment of the present invention. The system 420 **generally includes a media player 422 and a media device 424 that connect via a wireless communication link 426.** Both the media player 422 and the media device 424 may be widely varied. For ease of discussion, **the media device 424 corresponds to a second media player that is similar to the first media player**

[0108] The communication terminal 436 controls interactions with one or more media devices 424 that can be coupled to the media player 422 through a wireless link. The communication terminal 436 may include a transmitter, receiver or transceiver. In one embodiment, the first media player 422 includes a transmitter and the second media player 424 includes a receiver thereby providing one way communication therebetween. In the illustrated embodiment, **the first media player 422 includes a first transceiver and the second media player includes a second transceiver 424 for two way communication therebetween.** The transmitter is configured to transmit information over the wireless communication link and the receiver is configured to receive information over the wireless communication link while the transceiver is configured to both transmit and receive information over the wireless communication link.

(Emphasis added.)

Nothing in Fadell discloses or suggests that a media device should be used for “receiv[ing] audio-containing radio signals **from radio stations**” as required by amended claim 52 (and

disclosed at page 6, fourth paragraph<sup>1</sup> of Applicant's specification) `~~~~`. Rather, each wireless receiver described in the various embodiments of Fadell is intended to receive communication signals from another portable media player.

With the entire thrust and purpose of Fadell being to **allow a portable media player to communicate with other portable media playing devices**, any radio receiver provided in such a device according to Fadell is *not* used to receive radio signals from radio stations. Moreover, there exists no suggestion or motivation to modify Fadell to provide an FM receiver adapted to receive audio-containing radio signals from radio stations. Since Fadell concerns wireless transmission between portable devices with low transmission power capability commensurate with their battery powered nature, **it would frustrate the purpose of Fadell's espoused invention to apply the same receiver used for inter-device communication to further receive high-powered radio signals from radio stations**, since such high-powered radio station signals of similar frequency would interfere with reception of low-powered inter-device signals. It is well settled that a proposed modification that would render the prior art invention unsatisfactory for its intended purpose cannot support a suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Since Fadell fails to teach any FM receiver adapted to receive audio-containing radio signals from radio stations, and there exists no motivation to modify Fadell to include such an FM receiver, no *prima facie* case of obviousness premised on Fadell can be established pursuant to MPEP §§ 2143.01 & 2143.03.

(b) **A Boom Box Adapted to Receive an MP3 Player Need Not – and Often Does Not – Contain a Radio**

In the January 11, 2007 Advisory Action at page 3, the Examiner stated:

Applicant further argues that the sound system (or media device) 370 in figure 12 [of Fadell] does not have a radio receiver as claimed. The examiner, however, disagrees. Applicant's attention is directed to Fadell, paragraph [0058] which discloses that the media devices 154 comprises audio equipments such as **boom boxes**. **Such boom boxes clearly comprises (sic) AM/FM radio receiver**. ... Accordingly, the audio system 370

<sup>1</sup> **"Preferably, such audio player ... comprises an FM receiver coupled with the speakers for receiving radio signals from near-by radio stations."**

in figure 12 does comprise a FM receiver as claimed. (Emphasis added.)

Applicant takes issue with the Examiner's statement – unsupported by any evidence whatsoever - that the "boom box" mentioned by Fadell "clearly comprises [an] AM/FM radio receiver," for at least the reasons stated below.

(1) **Dictionary and Encyclopedia Entries Describe Boomboxes Without Radios**

Several prominent online dictionaries including "WordReference.com" and "WordWebOnline.com," define a "boom box" simply as "a **portable stereo**" – a definition that *omits any requirement that a radio be included*. See, e.g.:

<http://www.wordwebonline.com/en/BOOMBOX>; and

<http://www.wordreference.com/definition/boom%20box>

Online encyclopedias – expected to provide greater detail than dictionaries – are not inconsistent with the foregoing definitions. One highly respected online encyclopedia, [www.channelweb.com](http://www.channelweb.com), provides a highly detailed definition of a "boom box" that *omits the term "radio" entirely*, with such definition being reproduced below:

**Results found for: boom box**

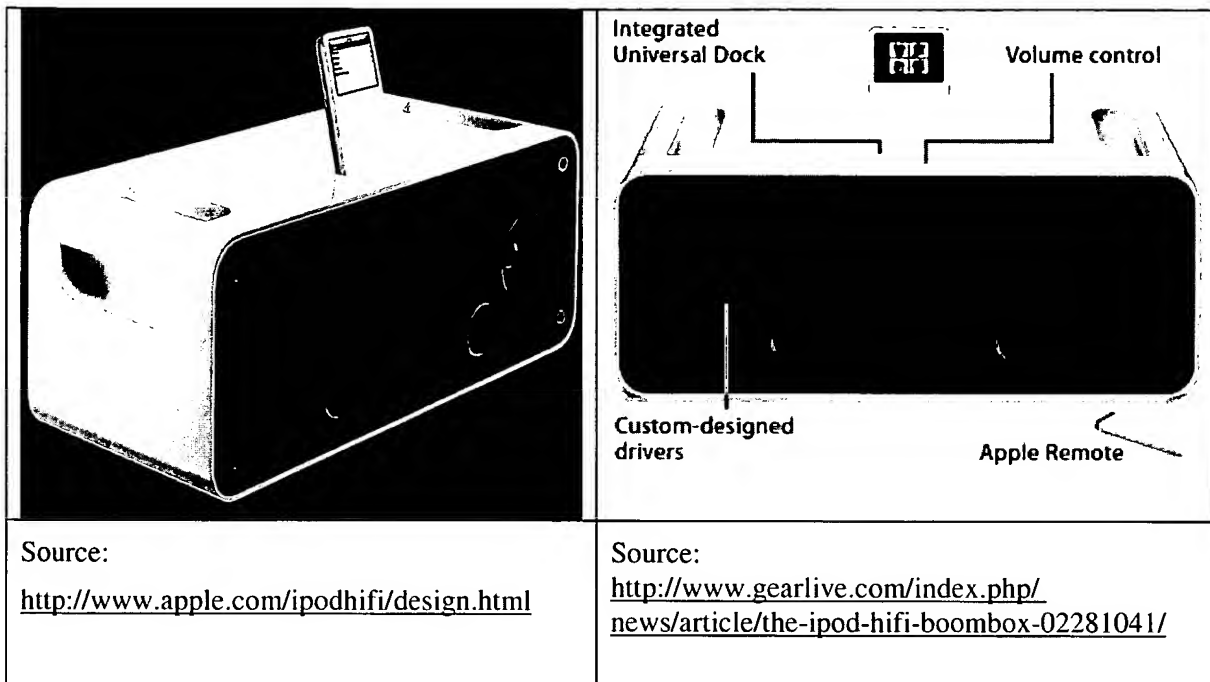
**A self-contained stereo system for playing music. Available in a myriad of styles, a boom box contains an amplifier, speakers and CD and/or tape cassette drives. The CD system plays standard CD-DA music tracks and may also play MP3 and other compressed audio formats. Some units accept memory cards for MP3 files. The equivalent of the "portable record player" of the 1960s, boom boxes are either small, battery-operated portables, or they are large, transportable units that require AC power. Battery-driven boxes typically have an AC power option.**

Source: <http://www.channelweb.com/encyclopedia/defineterm.jhtml?term=boom+box>

(2) **Apple Computer – the Assignee of Fadell – Produces and Sells the "iPod HiFi" Boombox, Which Closely Corresponds to the Fadell's Sound System 370" and Lacks a Radio**

Fadell clearly identifies on its cover page that the assignee of Fadell's U.S. Patent Application No. 10/423,490 is "Apple Computer, Inc." Apple Computer is the manufacturer of the popular iPod media player capable of playing and storing MP3 audio files. In early 2006 – just over a

year after Fadell was published – Apple Computer launched an iPod-compatible portable boombox called the “iPod HiFi.” Two pictures of the product are provided below:



Apple Computer’s launch of the iPod HiFi boombox product was widely covered by the media. The headlines for several examples of online stories discussing the iPod HiFi boombox, and URL links to such stories, are reproduced below.

### 1. The iPod Hi-Fi Boombox

February 28, 2006 at 12:00 PM

<http://www.gearlive.com/index.php/news/article/the-ipod-hifi-boombox-02281041/>

### 2. Apple announces iPod Hi-Fi boombox

Tuesday, February 28, 2006

<http://www.appleinsider.com/article.php?id=1561>

### 3. Apple powers up iPod Hi-Fi boombox

01 Mar 2006

<http://www.itweek.co.uk/vnunet/news/2151127/apple-unveils-ipod-boombox>

### 4. Apple announces new... iPod Hi-Fi Boombox

Tuesday, February 28th, 2006

<http://www.macenstein.com/default/archives/246>

## 5. Apple's New Boombastic Boom Box the iPod Hi-Fi

THURSDAY, MARCH 2, 2006

<http://www.macidol.com/reviews/ipod/accessories/>

## 6. Apple Unveils iPod 'Hi-Fi' Boombox

February 28, 2006, 1:40 PM

[http://www.betanews.com/article/Apple\\_Unveils\\_iPod\\_HiFi\\_Boombox/1141152053](http://www.betanews.com/article/Apple_Unveils_iPod_HiFi_Boombox/1141152053)

## 7. Apple launches iPod 'Hi-Fi' Boombox

Wednesday, March 1st, 2006

<http://www.techshout.com/gadgets/2006/01/apple-launches-ipod-hi-fi-boombox/>

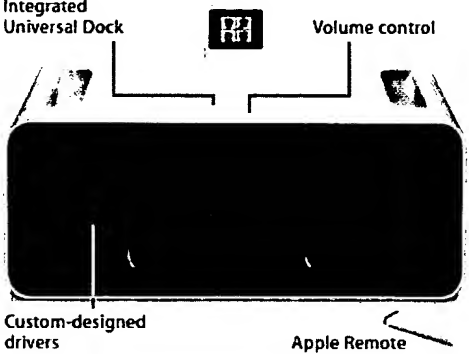
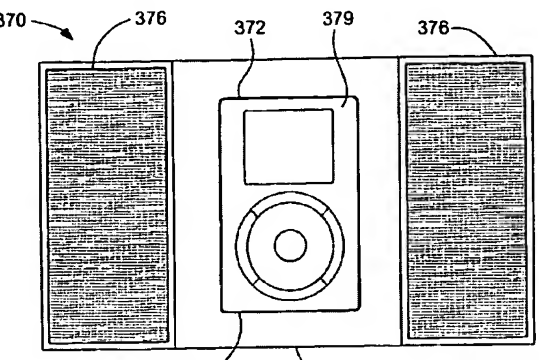
While it is unmistakably clear from the foregoing headlines and related stores that Apple's iPod HiFi is understood to be a "boom box," **multiple sources confirm that the iPod HiFi Boombox LACKS ANY RADIO whatsoever.**<sup>2</sup>

The close correspondence in structure and function between Apple's HiFi Boombox and the "sound system 370" of Fadell is likewise clear.

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<sup>2</sup> See, e.g., <http://www.gearlive.com/index.php/news/article/the-ipod-hifi-boombox-02281041/> ("The biggest of the "fun new" Apple products of the day turns out to be the iPod HiFi Boombox. ... The iPod Hi-Fi can be controlled with the Apple Remote, which comes bundled with the unit. It can also accept audio input through an auxiliary jack and SPDIF optical audio input, which means it can be used with non-iPod audio players. **Our only concern is the lack of an FM tuner.**"); and <http://washingtontimes.com/technology/20060320-093055-6260r.htm> ("Apple Computer's iPod Hi-Fi is a \$349 "boom box" of a stereo that may leave some folks scratching their heads. ... although some critics have bemoaned the lack of a built-in radio tuner, there's more than one way to compensate, it turns out. ... Check out the back of the iPod Hi-Fi and you'll see a "line in" jack that would handle your typical audio cable. But it also is equipped to handle digital audio cables.")



	 <p style="text-align: right;"><b>FIG. 12</b></p>
<p>Annotated Photograph of Apple's iPod HiFi Boombox (see gearlive.com Headline 1, above)</p> <p>"Its clean, all-in-one design features a unique isolated <b>enclosure system that includes two custom designed wide-range speakers</b> ... iPod Hi-Fi features handles to easily transport your stereo anywhere, a removable front grille with precision-mounting clips, touch-sensitive <b>volume control buttons</b>, the Apple Remote for easy <b>song and volume control</b> from anywhere in the room, a universal power supply incorporated into the all-in-one design ... and the ability to power iPod Hi-Fi from six D-cell batteries for true portability. ... [f]eaturing seamless integration with all iPods with a <b>dock connector</b> ... ."</p> <p>Text source:  <a href="http://www.apple.com/pr/library/2006/feb/28hifi.html">http://www.apple.com/pr/library/2006/feb/28hifi.html</a></p>	<p>Fadell FIG. 12, described in paragraph [0091] as follows:</p> <p>"FIG. 12 is front view of a <b>sound system 370 with an integrated docking station 372</b>, in accordance with one embodiment of the present invention. The sound system may be widely varied. For example, it may be a substantially fixed or portable unit. In the illustrated embodiment, <b>the sound system 370 is a flat panel unit that includes a base 374 and a pair of speakers 376</b>. ... The docking station 372 is integrated within the base 374. The docking station 372 includes a media bay 378 that may be placed anywhere on the base 374, as for example, the sides, top, front, back or bottom surfaces. The media bay 378 may be configured to receive any surface of a media player 379 ... .</p> <p>Fadell, paragraph [0091].</p>

From the items identified in the preceding table, consider the correspondence between features of the Apple iPod HiFi boombox and the "sound system 370" of Fadell, as identified below:

<u><b>Apple HiFi Boombox</b></u>	<u><b>Fadell's "Sound System 370"</b></u>
"enclosure system"	"sound system ... that includes a base 374"
"two ... wide-range speakers"	"pair of speakers 376"
"dock connector" on top of unit to receive iPod	"docking station 372 includes a media bay 378"

	that may be placed .... [on] the top surface ... to receive ... media player 379”
“six D-cell batteries for true portability”	“may be a ... portable unit”
no mention of any radio	no mention of any radio
no mention of any FM receiver adapted to receive radio signals from radio stations	no mention of any FM receiver adapted to receive radio signals from radio stations
no illustration or mention of any radio frequency indicator or frequency tuning control	no illustration or mention of any radio frequency indicator or frequency tuning control

(3) **Numerous Other Manufacturers Sell MP3 Docking Portable Amplified Speaker-Containing Devices Lacking Radios and Termed “Boomboxes”**

It is no fluke that Apple’s iPod HiFi lacks a radio but is still called a boombox, since numerous other manufacturers also sell as “boomboxes” portable amplified speaker-containing devices useful for docking MP3 players but lacking radios. See, e.g., **Harman Kardon “Go + Play iPod docking boombox”** described at <http://www.pcmag.com/article2/0,1895,2015354,00.asp> with a headline of “A Futuristic and Advanced iPod Boombox;” and **MTX iThunder “the portable boom box music sharing system for your iPod”** illustrated and described at <http://www.mtx.com/ithunder/>. Both of these boombox products are currently offered for sale, and neither contains any radio.

(c) **The Examiner’s Rejection Premised Solely on “Common Knowledge” is Legally Insupportable Under MPEP 2144.03**

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. MPEP 2144.03. As noted by the predecessor court to the Federal Circuit in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a

rejection was based. See *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ 421; MPEP 2144.03.

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

Applicant has provided herewith substantial evidence demonstrating that portable amplified speaker systems for use with MP3 players and lacking radio receivers are widely recognized as being "boom boxes." **It is particularly compelling that Apple Computer** – the very same assignee named on the cover page of Fadell – **sells a portable boombox product** (i.e., the "iPod HiFi") **that lacks a radio and conforms almost exactly in character to the "sound system 370"** disclosed by Fadell. **Such evidence clearly refutes the Examiner's unsupported theory that a 'FM receiver adapted to receive audio-containing radio signals' is clearly disclosed as present in the "sound system 370" of Fadell.**

To the extent that the Examiner is tempted to maintain his position (i.e., that Fadell discloses a radio in the sound system 370) such rejection in the face of such clear evidence to the contrary, **Applicant hereby challenges the Examiner, pursuant to MPEP 2144.03, to provide an affidavit or declaration setting forth specific factual statements and explanation to support his factual finding as "instant[ly] and unquestionabl[y] demonstrate[d]."** *Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420. If the examiner is unable to do so, the 103(a) rejections must be withdrawn pursuant to MPEP 2144.03.

### 3. Discussion of Qureshey and Lack of Motivation to Combine with Fadell

Qureshey discloses a network-enabled audio device consistent with conventional stereo receivers, except for the addition of certain network capabilities. No docking cavity is disclosed. The Examiner relies upon Qureshey because it teaches a frequency tuning control and a frequency indicator on a main body portion. Advisory Action, page 4. Applicant does not

dispute the disclosure of Qureshey in this regard. What Applicant does dispute is any motivation to combine Qureshey with Fadell.

As indicated previously, Fadell does teach a “sound system 370” having a docking cavity and at least one speaker, but Fadell fails to teach any FM receiver adapted to receive audio-containing radio signals from radio stations, or in association therewith a frequency indicator disposed on the main body portion and a frequency tuning control disposed on the main body portion.

In the November 15, 2006 Office Action, the Examiner stated:

[I]t would have been obvious to one of ordinary skill in the art at the time of the invention to provide (sic – *apply*) the ... teaching of Qureshey [namely, any audio player having a main body portion comprising a frequency indicator and frequency tuning control] to Fadell, in order to allow the user to easily visualize which channel the FM receiver is tuned to.

Since Fadell fails to teach or suggest any FM receiver adapted to receive audio-containing radio signals from radio stations, there exists no reason to add a frequency indicator and frequency tuning control to allow the user to easily visualize the channel to which such FM receiver is tuned. This is consistent with the lack of any frequency indicator or frequency tuning control illustrated or described in connection with the sound system 370 of Fadell FIG. 12, and with the lack of any frequency indicator or frequency tuning control (or FM receiver) in the Apple iPod HiFi boombox corresponding so closely to Fadell’s sound system 370.

Since there exists no motivation to combine the radio-related features of Qureshey’s conventional stereo receiver with Fadell’s sound system 370 adapted for inter-portable-device communication, no *prima facie* case of obviousness has been established as to amended claim 52. Accordingly, withdrawal of the § 103 rejection of claim 52 – and of all claims depending therefrom – is respectfully requested.

#### 4. Renewed Request for Consideration of Objective (Secondary) Evidence of Non-Obviousness

In the January 11, 2007 Office Action, the Examiner dismissed as unpersuasive the evidence of secondary considerations of non-obviousness provided by Applicant (i.e., Declaration of Jeff

Grady). Advisory Action, pages 7-8. Applicant hereby requests reconsideration by the Examiner of such evidence.

The Examiner states that “gross sales figures do not show commercial success absent evidence as to market share, or the time period during which the product was sold, or the normally expected sales in the market.” Advisory Action, page 8. The Examiner has improperly ignored evidence of at least two of these factors presented in the Declaration of Jeff Grady.

Mr. Grady’s Declaration states, *inter alia*:

4. Within the past two years, Netalog has sold more than eighty-five thousand (85,000) examples of the IBOOM® boombox. Netalog’s IBOOM® boombox initially was introduced with a Manufacturer’s Suggested Retail Price of \$149.99. Such price was subsequently reduced to \$129.00, and more recently to the current price of \$99.00. While retailers have some latitude to adjust actual sales prices, it is believed that the aggregate revenue generated by sales of the IBOOM® boombox have exceeded \$8.5 million.

5. I am not aware of any other audio player assembly antedating either (1) the filing of the present application or (2) Netalog’s introduction of the IBOOM® boombox, and embodying the four features identified above.

6. Following Netalog’s introduction of the IBOOM® boombox, however, I have become aware of a substantial number of other audio player assemblies introduced to the market and embodying the four features identified above. Such products are identified in **Exhibits B-U**, as appended hereto.

Thus, evidence has been presented that Netalog sold more than 85,000 units of the IBOOM boombox within two years. This provides ample evidence of the “time period during which the product was sold.”

Furthermore, Mr. Grady’s statement that he was unaware of any other product embodying the features of the pending patent claims at the time the IBOOM® boombox was introduced provides evidence that, as of its introduction, **the IBOOM® product had a 100% market share for products within the scope of the present patent claims at the time the IBOOM® boombox was introduced**. Mr. Grady has further provided evidence that, since the introduction of the IBOOM® boombox, at least **nineteen (19) other products embodying the inventive features now claimed** have been introduced to the market. It should be presumed that commercial

success of the IBOOM® boombox would have been much greater in the absence of such competing products.

The Examiner has wholly failed to address the presence of the overwhelming evidence of success of potentially infringing third party products. Federal Circuit case law provides that secondary considerations may include success of a potentially infringing product, *i.e.*, a product manufactured by a third party<sup>3</sup>. Applicant has identified nineteen (19) other products introduced to the market after the filing of the present patent application and after introduction of the IBOOM® boombox to the market. (See Grady Declaration.) While Applicant does not have access to sales figures or market share for such third party products, **the fact that so many products embodying the same features (*i.e.*, features within the scope of the present patent claims) have been introduced very close in time to one another provides an irrefutable inference of substantial third party commercial success.** Otherwise, so many different products could not coexist in the market and so many different manufacturers would not undertake the risk of selling such products in a competitive marketplace

In this instance, the third party commercial success in selling products highly similar to Netalog's IBOOM® boombox – *after* Applicant invented the subject matter claimed in the present application – evidences the non-obviousness of Applicant's invention. If the invention were in fact obvious at the time the present application was filed, then the profit motive would have been a powerful incentive for third parties to have beaten Applicant to the punch in commercializing products embodying the invention. Such third party commercialization did not occur until **after** Applicant's invention of the subject matter now claimed.

Accordingly, the Examiner is requested to reconsider all of the pertinent objective evidence of the non-obviousness of the invention as presently claimed, and withdraw the obviousness rejections under 35 USC § 103.

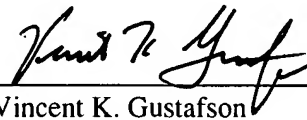
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<sup>3</sup> See *Brown & Williamson Tobacco Corp. v. Phillip Morris Inc.*, 229 F.3d 1120, 56 USPQ2d 1456, 1464 (Fed. Cir. 2000) (evidence of infringing product in patent infringement action considered in secondary considerations).

**CONCLUSION**

Based on the foregoing, all of applicants' pending claims 1, 3-6, 9-11, 14-24, 27, and 30-68 are therefore patently distinguished over the art, and in form and condition for allowance. The examiner is requested to favorably consider the foregoing, and to responsively issue a Notice of Allowance. If any issues require further resolution, the examiner is requested to contact the undersigned attorney at (919) 419-9350 to discuss same.

Respectfully submitted,



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